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09/925,443	08/09/2001	Mary Louise Parker	515265-2001	4098
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FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151				
			EXAMINER COLLINS, DOLORES R	
			ART UNIT 3712	PAPER NUMBER 12
DATE MAILED: 03/08/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/925,443

Applicant(s)

PARKER, MARY LOUISE

Examiner

Dolores R. Collins

Art Unit

3712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9, 14-22 and 36-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 14-22 and 36-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Upon further consideration of this application, the subject matter contained in claims 1-9, 14-22 & 36-39 is no longer considered allowable. The office action of 8/21/03 is withdrawn. A new office action on the merits is presented below. Please excuse the delay in prosecution.

#### ***Response to Amendment***

Examiner acknowledges response by applicant's representative received 1/8/04. Examiner further acknowledges the cancellation of claims 10-13, 23-35 & 40-62.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

1. Claim 36 recites the limitation "said circular portion" in lines 6-7. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 4 & 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Ide et al. (683).

Ide et al. disclose a Feeding Method And Article, which teaches a substantially flat central portion (as seen in the center of fig. 5), a raised side surface positioned coaxially with a flat central portion (figure 6, (40)) and removable tabs (44): examiner interpreting the removable design-bearing plates as removable tabs with text thereon (page 2, col. 2, lines 38-45 & 59-68).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3, 7-9 & 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ide et al. (683) in view of Schneider.

Regarding claims 1, 14 & 17

Ide et al. disclose a Feeding Method And Article, which teaches a substantially flat central portion (as seen in the center of fig. 5), a raised side surface positioned coaxially with a flat central portion (figure 6, (40)) and removable tabs (44) with characters printed thereon (page 2, col. 2, lines 59-68). Ide fails to teach axial perforations, which define the portion where the removable tab is located.

Schneider discloses a Portion Access Pie Plate, which teaches perforations, which define sections of his plate (figure 1, (16)). Further, once the perforated sections are removed, the plate still retains a consistent overall diameter (as seen in figure 2). It would have been obvious in view of Schneider to modify the plate/container of Ide in order to make it easier for the players to remove the tabs necessary for game play.

Regarding claims 2-3, 7-9 & 15-16

Ide et al. in view of Schneider teaches the claimed invention except for the specific arrangement and/or content of indicia (printed matter) set forth in the claim(s). It would have been obvious to one having ordinary skill in the art at the time the invention was made to include statements questions and answers on the tabs since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of indicia does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter e.g. characters and the substrate e.g. statements (questions/answers) which is required for patentability.

4. Claims 5-6 & 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ide et al. (683).

Ide et al. disclose a Feeding Method And Article, which teaches a substantially flat central portion (as seen in the center of fig. 5), a raised side surface positioned coaxially with a flat central portion (figure 6, (40)) and removable tabs (44) with characters printed thereon (page 2, col. 2, lines 59-68).

Ide et al. disclose the claimed invention except for the specific arrangement and/or content of indicia (printed matter) set forth in the claim(s). It would have been obvious to one having ordinary skill in the art at the time the invention was made to include statements questions and answers on the tabs since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of indicia does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter e.g. characters and the substrate e.g. statements (questions/answers) which is required for patentability.

5. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ide et al. as applied to claim 18 above, and further in view of Jones.

Ide et al. disclose a Feeding Method And Article, which teaches a substantially flat central portion (as seen in the center of fig. 5), a raised side surface positioned coaxially with a flat central portion (figure 6, (40)) and removable tabs (44) with characters printed thereon (page 2, col. 2, lines 59-68).

Ide et al. disclose the claimed invention but fails to explicitly teach that his tabs comprise lightly coated adhesive strips that may be peeled off.

Jones discloses a package label with and adhesive backing (see abstract and figures 1 & 2). It would have been obvious in view of Jones to include adhesive as a retaining means for the Ide's tabs in order provide additional security for them during game play.



6. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ide et al. as applied to claim 18 above, and further in view of applicant's admission in the specification, on page 14, lines 8-10.

By applicant's own admission, scratch-off techniques are well known in the art. It would have been obvious to use any scratch-off technique (e.g. as seen on many lottery tickets) as a means of concealing the text while at the same time providing an element of mystery for the participants.

7. Claims 36-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ide et al. (683) in view of Schneider (484) and further in view of Jones (746).

Regarding claim 36

Ide et al. disclose a Feeding Method And Article, which teaches a substantially flat central portion (as seen in the center of fig. 5), a raised side surface positioned coaxially with a flat central portion (figure 6, (40)) and removable tabs (44) with characters printed thereon (page 2, col. 2, lines 59-68). Ide fails to teach axial perforations, which define the portion where the removable tab is located.

Schneider discloses a Portion Access Pie Plate, which teaches perforations, which define sections of his plate (figure 1, (16)). Further, once the perforated sections are removed, the plate still retains a consistent overall diameter (as seen in figure 2). It

would have been obvious in view of Schneider to modify the plate/container of Ide in order to make it easier for the players to remove the tabs necessary for game play.

Further, Ide et al. fails to explicitly teach that his tabs comprise lightly coated adhesive strips that may be peeled off.

Jones discloses a package label with an adhesive backing (see abstract and figures 1 & 2). It would have been obvious in view of Jones to include adhesive as a retaining means for the Ide's tabs in order to provide additional security for them during game play.

Regarding claims 37 & 38

Ide et al. in view of Schneider and further in view of Jones teach the claimed invention except for the specific arrangement and/or content of indicia (printed matter) set forth in the claim(s). It would have been obvious to one having ordinary skill in the art at the time the invention was made to include statements, questions and answers on the tabs since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of indicia does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus,

there is no novel and unobvious functional relationship between the printed matter e.g. characters and the substrate e.g. statements (questions/answers) which is required for patentability.

### Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Johnson, Nalle, Laske, Jr., Schneider, Smith et al., Stubbmann, Dunbar, Russo, Shank, Jr. & Ervin are cited to show the state of art with respect to features of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Dolores R. Collins** whose telephone number is **(703) 308-8352**. The examiner can normally be reached on 9:00 A.M. - 5:30 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Derris Banks** can be reached on **(703) 308-1745**. The fax phone numbers for the organization where this application or proceeding is assigned are **(703) 305-3579** for regular communications and **(703) 305-3579** for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is **(703) 308-1148**.

  
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March 3, 2004



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